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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/945,378

Filing Date: August 31, 2001

Appellant(s): GRAHAM ET AL.

MAILED

SEP 11 2007

GROUP 3600

David A. Mancino
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/5/2007 appealing from the Office action

mailed 9/6/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6764395	GUYETT	7-2004
20030191690	MCINTYRE	10-2003
5679075	FORREST	10-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 33-37, 42, 44-49 and 64-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyett (U.S. Patent No. 6,764,395) in view of McIntyre (U.S. Pub No. 2003/0191690).

Regarding claims 33, 42 and 64-70, Guyett teaches providing an interactive advertising message (game or puzzle containing a question) to a consumer (Column 2, Lines 39-46) and gathering data associated with the consumer's interactions with the message (Column 10, Lines 17-20). Guyett doesn't specify generating a statistical report and sending it to the commercial entity. McIntyre teaches a statistical report that keeps track of how many times a game is played and the sending of this report to sponsors of the game (Paragraph 0008). It would have been obvious to one having

ordinary skill in the art at the time the invention was made to provide a report to the commercial entity. This would aid the commercial entity in knowing how well-received their game is. Regarding claims 64-66 and 68-70, which introduce the specific data content of the statistical report, it could be argued that Guyett and McIntyre do not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of data content. Such data content does not functionally relate to the steps and the subjective interpretation

Regarding claims 34, and 35, Guyett teaches the game as being provided on a computer over the Internet (Column 5, Lines 44-52).

Regarding claims 36, and 37, Guyett teaches the playing of a series of games (Column 7, Lines 5-8). Guyett teaches selecting the plurality of games based on demographics (Column 6, Lines 40-42). This reads on providing the next of the plurality based on demographics.

Regarding claims 44 and 46-49, Guyett teaches monitoring player behavior and recording this into a database in connection with advertisements (Column 6, Lines 19-22). Guyett doesn't specify that the game gathers data related to brand type, taglines,

product benefits, imagery, and communication language in particular. Official notice is taken that it is old and well-known that advertisements frequently contain brand type, taglines, product benefits, imagery, and communication language. It would have been obvious to one having ordinary skill in the art at the time the invention was made to gather information related not only to advertisements in general, but also related to the above categories. This would allow the advertiser to understand more about how their product is doing in the marketplace.

Regarding claim 45, Guyett teaches gathering data (player history) related to a commercial entity's products (Column 1, Lines 25-27).

Claims 38-41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guyett (U.S. Patent No. 6,764,395) in view of McIntyre (U.S. Pub No. 2003/0191690), and further in view of Forrest (U.S. Patent No. 5,679,075).

Regarding claims 38-41, and 43, Guyett teaches recording the performance history of a player (Column 10, Lines 13-16). Guyett also teaches a plurality of puzzles, but doesn't teach the providing of a next of the plurality of puzzles based on consumer performance. Forrest teaches an interactive multimedia game using multiple puzzles that gives the user a new puzzle based on a satisfactory performance for the previous puzzle (Column 8, Lines 6-9, and Column 8, Lines 18-19). It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a puzzle for the user based on performance of the user. This would give the player a greater sense of satisfaction. Guyett teaches the playing of a series of games (Column

7, Lines 5-8). Guyett teaches selecting the plurality of games based on demographics (Column 6, Lines 40-42). This reads on providing the next of the plurality based on demographics. The puzzles of Guyett are taken to inherently include marketing messages.

(10) Response to Argument

Response to Appellants arguments of the 103 rejection over claims 33-37, 42, 45, and 67. Appellant alleges that McIntyre teaches away from the claimed invention by arguing “McIntyre discloses that advertisers are not to be directly contacted, thereby inhibiting receiving any consumer feedback”. The portion of McIntyre to which Appellant refers uses this language “By using a host server 26, the actual sponsor need not ever be actually contacted”. This means that the sponsor does not have to be contacted, as opposed to Appellant’s argument which indicates that advertisers are “not to be” contacted. This argument makes it sound like McIntyre is teaching that a restriction be imposed preventing the advertiser from being contacted, which is not the case.

Regardless of this interpretational issue, this cited portion of McIntyre does not teach away from the claimed invention, and in fact, does not even relate to the portion of McIntyre cited and used in the 103 rejection by Examiner. The portion cited by Appellant relates to inputting predetermined information into the system so the Advertiser does not have to be contacted when decisions are made. This relates to the

types of games to which an advertisement is supposed to be supplied. This does not, however, relate to billing. The act of billing inherently comprises providing certain key information to the entity being billed. An act of billing is inherently communication. McIntyre does indeed teach providing a statistical report (bill based on number of advertising views) to a commercial entity.

Applicant continues to argue "Appellant's claimed statistical report is not the same thing as McIntyre's bill". Examiner contends that "statistical report" is a broad term, and since the bill of McIntyre is based on number of times an advertisement is viewed, it is indeed a statistical report.

Response to Appellants arguments of the 103 rejection over claims 44 and 46-49. While the Appellant agrees that Examiner's taking of Official Notice is correct (that brand type, tag lines, product benefits, imagery, and communication language are all commonly found in advertisements), Appellant argues "just because such categories of data may be present in particular forms of advertisements, it does not follow that there exists any disclosure in either Guyett or McIntyre to gather or process such data". Examiner contends that if there was disclosure for the exact word-for-word process claimed by Appellant, then this would be a 102 rejection. Examiner has instead, stated that, based on the teachings of Guyett, it would be obvious to test for the above types of data. Guyett teaches testing consumers about products seen in advertisements, and as such, it would be obvious to test and store results on all the other aspects of an advertisement. Appellant argues that Examiner has used hindsight, when in fact, this

type of testing would be obvious to anyone skilled in the art or marketing research regardless of Appellant's specification. If testing is conducted on knowledge of an advertisement, and specifically a product, also testing such items as product benefits and brand name would simply be a logical extension of such testing.

Response to Appellants arguments of the 103 rejection over claims 64-66 and 68-70. Appellant argues "the material printed on the statistical report has a functional relationship to the statistical report itself and to the method of generating the statistical report". The claim language of these contested claims reads "wherein the statistical report will illustrate". This specific information in the statistical report is never used for any sort of further analysis in any other claim language. These claims simply set forth the type of information conveyed in the report. For example, the method would be performed exactly the same between claims 64 and 65 other than printing information A on the report as opposed to information B. The illustrated information is simply non-functional descriptive material.

Response to Appellants arguments of the 103 rejection over claims 38-41 and 43. Appellant argues "claims 38-41 and 43 includes limitations requiring the selection of a next interactive advertising message based upon the feedback received from the consumer". Appellant then continues to argue that since McIntyre does not contact the advertiser, this combination is not feasible. Appellant's arguments of the alleged "teaching away" of McIntyre have already been addressed above, and Examiner

does not see anything further in these dependent claims about contacting an advertiser. Examiner has not found reviewed the arguments and has not found any arguments for these claims that have not already been addressed in the above paragraphs of this Examiner's Answer.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Bekerman 

Conferees:

Eric Stamber 

Jeff Carlson 